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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,437	12/14/2003	DAVID LIANG MABBUTT	DMABB05F	1436
33310	7590	02/26/2008		
EDWIN A. SKOCH II 110 WALL STREET, 11th FLOOR PMB#0029 NEW YORK, NY 10005			EXAMINER BAXTER, GWENDOLYN WRENN	
			ART UNIT 3632	PAPER NUMBER
			MAIL DATE 02/26/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,437	Applicant(s) MABBUTT, DAVID LIANG	
	Examiner Gwendolyn Baxter	Art Unit 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 6, 8 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6, 8 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This is the fourth office action for serial number 10/707,437, Improved Mouse pad filed December 14, 2004.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the golf hole must be shown or the feature canceled from the claim 6. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,125,032 to Gillespie in view of U.S. Patent No. 6,644,605 B1 to Tyner and in further view of U.S. Patent No. 6,837,769 to Skov. The present invention reads on Gillespie as follows: Gillespie teaches a mouse pad (28) comprising a mouse pad (28) with one or more connectedly attached members (34, 10) at or near the edge of the mouse pad. The member or members protrude above the surface of the mouse pad in a roughly perpendicular fashion and provide a barrier to discourage mouse movement off that edge of the mouse pad where the member or member is located. See figures 3 and 4. Although a tropical theme is shown, sport themes with artistic indicia relating to baseball or football are encouraged as well (col. 2, lines 64 through col. 3, line 1). Gillespie clearly teaches the anchoring of the member or members to the mouse pad (28) via the pegs (34); however, fails to teach the member or members being anchored in the mouse pad.

Tyner teaches a mouse-supporting surface (20). The supporting surface includes apertures (39) for receiving one or more members (220) via post or pegs (222) anchored in and protruding above the surface of the mouse supporting surface in a roughly perpendicular fashion. Figure 9 of Tyner illustrates the post being inserted completely through the thickness of the supporting surface such that the end is able to be flush with the under surface of the supporting surface furthest from the upper surface of the supporting surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the members and mouse pad as taught by Gillespie to have incorporated the pegs on the bottom of the member or member while the mouse pad provided with the openings for receiving the pegs therein as taught by Tyner, as an alternate means of securing the member or members to the supporting surface, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art as a obvious expedient.

Gillespie in view of Tyner fails to teach the post having an end with a thickness greater than the thickness of remainder of the post. Skov teaches an article or member (1) to be anchored and mounted to a horizontal surface (2). The article includes a post (14). The end (18) of the post (14) has a thickness greater than the thickness of the remainder of the post (14). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the post as taught by Gillespie in view of Tyner to have incorporated the end of Skov for the purpose of providing additional contact surface or area to further stabilize the member to the mouse pad thus preventing easy removal of the device.

Claims 4, 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillespie in view of Tyner and Skov, as applied to claim 1, and in further view of U.S. Patent No. 5,709,385 to Fitzpatrick. Gillespie in view Tyner and Skov teaches the limitations of the base claim. In fact, Gillespie encourages the changing of themes such as a tropical or sport theme with artistic indicia relating thereto (col. 2, lines 64+). However, Gillespie fails to teach a shape of a hockey goal or basketball post, backboard, and hoop and appearance of a hockey rink or basketball court and fails to teach the post having flattened, roughly circular section parallel to the upper surface of the mouse pad.

Fitzpatrick teaches a member that is mounted to a supporting surface. The member has a post (41) having a flattened, roughly circular section (not numbered but found below the reference numeral 41). See figure 11. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the post as taught by Gillespie in view of Tyner and Skov to have incorporated the plate as taught by Fitzpatrick for the purpose of preventing the member wobbling from side to side increasing the contact area of the member and the supporting surface. Additionally, it would have been an obvious matter of design choice to shape the mouse pad as a full or partial hockey rink or basket ball court or to make the member or members in the shape of a hockey goal or basketball post, backboard and hoop, since such a modification would have involved a mere change in the shape of components. A change in shape is generally recognized as being within the level of ordinary skill in the art, since the configuration of the claimed mouse pad or member is not significant.

Additionally, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the mouse pad and member or members to have the appearance of hockey goal and partial rink or a basketball post and partial court, since it has been held to be within the general skill of a worker in the art to select a change in aesthetic design as a matter of obvious design choice.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillespie in view of Tyner and Skov, as applied to claim 1, and in further view of non-patent literature, Information Fairway Mouse Pad, herein after Info Mouse Pad and U.S. Patent No. 5,709,385 to Fitzpatrick. Gillespie in view of Tyner and Skov teaches the limitations of the base claim, excluding the members is in the shape of a golf hole, post and flag and the post having flattened, roughly circular. The present invention reads on Information Fairway Mouse Pad as follows: the Information Fairway Mouse Pad teaches a mouse pad comprising a mouse pad with one or more connectedly attached members (the flag) at or near the edge of the mouse pad. The member or members protrude above the surface of the mouse pad in a roughly perpendicular fashion and provide a barrier to discourage mouse movement off that edge of the mouse pad where the member or member is located. The member or members are in the shape of a golf hole, post and flag. The mouse pad has the appearance of a full or partial golf green. The flag provides the area necessary for displaying graphics or text used for promotion purposes.

Fitzpatrick teaches a member that is mounted to a supporting surface. The member has a post (41) having a flattened, roughly circular section (not numbered but

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found below the reference numeral 41). See figure 11. It would have been obvious to one having ordinary skill in the art at the time invention was made to have modified the mouse pad and the members as taught by Gillespie in view of Tyner and Skov to have incorporated the shape and design of the mouse pad and member as taught by the non-patent literature, Information Fairway Mouse Pad for the purpose of appealing to golfing enthusiast. Additionally, it would have been an obvious matter of design choice to shape the mouse pad as a partial golf green, wherein the member is in the shape of a golf hole, post and flag, since such a modification would have involved a mere change in the shape of components. A change in shape is generally recognized as being within the level of ordinary skill in the art, since the configuration of the claimed mouse pad or member is not significant and, since it has been held to be within the general skill of a worker in the art to select a change in aesthetic design as a matter of obvious design choice. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the post as taught by Gillespie in view of Tyner, Skov and non-patent literature, Information Fairway Mouse Pad, to have incorporated the plate as taught by Fitzpatrick for the purpose of preventing the member wobbling from side to side increasing the contact area of the member and the supporting surface.

Response to Arguments

Applicant's arguments with respect to claims 1, 4, 6, 8 and 11 have been considered but are moot in view of the new grounds of rejection.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that Examiner did not directly address the limitation of claim 11 directed to the use of a mouse pad with accessories to be used to play a sport in miniature, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant argues the non-patent literature is not dated. The second page of this literature provides a copy right date of the website, which is 1997-2003.

Applicant argues the non-literature does not teach a hole on the green. This is the hole receiving the golf post.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn Baxter whose telephone number is 571-272-6814. The examiner can normally be reached on Monday-Wednesday, 8:30am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gwendolyn Baxter/
Primary Examiner, Art Unit 3632

February 13, 2008